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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,728	10/29/2001	Seth P. Becker	BEC-0041	9760

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KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> <b>10/020,728</b>	<b>Applicant(s)</b>	
	<b>Becker et al.</b>	
<b>Examiner</b> <b>Alexander Kalinowski</b>	<b>Art Unit</b> <b>3626</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Oct 29, 2001

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 1-27 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-27 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. Claims 1-27 are presented for examination.

### *Specification*

2. The abstract of the disclosure is objected to because the abstract contains more than 150 words. Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5 8, 9, 13-22, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker et al., Pat. No. 5,983,238 (hereinafter Becker).

As to claim 1, Becker discloses a system for providing registration services and loss protection services related to marked jewelry (see abstract), comprising:  
a database for registering said marked jewelry (i.e. diamond registration)((col. 4, lines 37-45); and  
a loss protection system in communication with said database for bundling said registration service with said loss protection services related to said marked jewelry (i.e. police, insurance companies, store owners ... may contact the central headquarters)(col. 4, lines 8-36).

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As to claim 2, Becker discloses the system of claim 1 wherein said database includes ownership data related to said marked jewelry (i.e. col. 4, lines 37-40).

As to claim 3, Becker discloses the system of claim 1 wherein said database includes distinguishing characteristics of said marked jewelry for tracking and identification purposes (col. 3, lines 37-40).

As to claim 5, Becker discloses the system of claim 1 wherein said database includes value of said marked jewelry (Fig. 10).

As to claim 8, Becker discloses the system of claim 1 wherein said loss protection systems provides said database with transfer of ownership data (col. 5, lines 9-18).

As to claim 9, Becker discloses the system of claim 1 wherein said loss protection systems provides said database with occurrence of events relating to said marked jewelry including one of theft, loss, destruction and recovery (Fig. 15).

As to claim 13, Becker discloses the system of claim 1 wherein the database and the loss protection system are implemented by the same system (see abstract).

As to claim 14, Becker discloses the system of claim 1 wherein the database includes an identification of marking on the marked jewelry item (Fig. 2).

As to claim 15, Becker discloses a method for providing registration services and loss protection services related to marked jewelry (see abstract), comprising: initiating said registration services by registering a marked jewelry item in a database (i.e. diamond registration)((col. 4, lines 37-45);

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initiating said loss protection services (see abstract);  
bundling the registration services with the loss protection services (i.e. police, insurance companies, store owners ... may contact the central headquarters)(see Fig. 15, Fig. 16, and col. 4, lines 8-36);  
providing the bundled registration services and loss protection services to a consumer (col. 4, lines 21-24); and,  
updating said database upon an occurrence of an event relating to said marked jewelry item (col. 5, lines 9-18).

As to claim 16, Becker discloses the method of claim 15 wherein the updating said database occurs upon one of a transfer of ownership, loss, destruction, theft, damage, recovery and settlements initiated (Fig. 15).

As to claim 17, Becker discloses the method of claim 15 wherein terms of loss protection services include identification information for said marked jewelry item (Fig. 4).

As to claim 18, Becker discloses the method of claim 15 wherein terms of loss protection services include a value of said marked jewelry item (Fig. 10).

As to claim 19, Becker discloses the method of claim 15 wherein terms of loss protection services include ownership information related to said marked jewelry item (Fig. 11).

As to claim 20, Becker discloses the method of claim 15 wherein said marked jewelry item includes a jewelry item that has been marked with an identification marking (Fig. 2).

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As to claim 21, Becker discloses the method of claim 15 wherein said database is a commercial database accessible by authorized entities (col. 4, lines 21-26).

As to claim 22, the method of claim 15 wherein said initiating said loss protection service agreement includes collecting activation information and transferring said activation information to a provider of said loss protection services.

As to claim 27, Becker discloses the method of claim 15 wherein the registration services and the loss protection services are provided by the same entity (see abstract).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker as applied to claim 1 above, and further in view of Examiner's use of Official Notice.

As to claim 4, Becker does not explicitly disclose the system of claim 1 wherein said database includes fees collected and owed.

However, the Examiner takes official notice that it was well known in the electronic billing arts to track billing information including fees collected and owed. Such a system provides the means for determining how much is owed, how much is paid for a particular product or service.

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For example, student loans are processed on am monthly basis. Billing information includes the amount owed and principal paid. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said database includes fees collected and owed within Becker for the motivation stated above.

7. Claims 6-7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker as applied to claim 1 above, and further in view of "Insure your Reputation: Introducing GemShield, Private Insurance from IJB" (hereinafter GemShield).

As to claim 6, Becker does not explicitly disclose the system of claim 1 wherein said loss protection systems provides said database with policy data relating to coverage terms selected.

However, Jewelers Mutual discloses providing policy data relating to coverage terms selected (page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection systems provides said database with policy data relating to coverage terms selected within Becker for the motivation of providing protection commensurate with the level of coverage obtained (i.e. we provide loss, theft, and damage protection. Some homeowners policies are limited in coverage ...)(page 1).

As to claim 7, Becker does not explicitly disclose the system of claim 1 wherein said loss protection systems provides said database with updated inspection data relating to said marked jewelry.

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However, Becker discloses updating the database with respect to the registered marked jewelry. Furthermore, Jewelers Mutual discloses requiring inspections relating to said jewelry (page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection systems provides said database with updated inspection data relating to said marked jewelry within Becker for the motivation of acknowledging required inspections for the marked jewelry.

As to claim 10, Becker does not explicitly disclose the system of claim 1 wherein said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services.

However, GemShield discloses said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services (i.e. individual choice)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services as disclosed by GemShield within Becker for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

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As to claim 11, Becker does not explicitly disclose the system of claim 1 wherein said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer.

However, GemShield discloses said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer (i.e. value added)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer as disclosed by GemShield within Becker for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

8. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Becker and GemShield as applied to claim 11 above, and further in view of "S&P Assigns Jewelers Mutual insurance 'BBBpi' Rating"(hereinafter S&P).

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As to claim 12, Becker does not explicitly disclose the system of claim 11 wherein a wholesaler includes the registration services and loss protection services in the cost of the jewelry item.

However, GemShield discloses including the registration services and loss protection services in the cost of the jewelry item(i.e. value added)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the registration services and loss protection services in the cost of the jewelry item as disclosed by GemShield within Becker for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

Becker and GemShield do not explicitly disclose the wholesaler transferring the jewelry item to at least one entity prior to the consumer obtaining the jewelry item.

However, S&P discloses the wholesaler transferring the jewelry item to at least one entity prior to the consumer obtaining the jewelry item (i.e. wholesalers, retailers, ...)(see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the wholesaler transferring the jewelry item to at least one entity prior to the consumer obtaining the jewelry item as disclosed by S&P within the Becker and GemShield combination for the motivation of providing coverage for the commercial jewelry industry and for individuals who own jewelry (see abstract).

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9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker as applied to claim 15 above, and further in view of GemShield.

As to claim 23, Becker does not explicitly disclose the method of claim 15 wherein said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services.

However, GemShield discloses said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services (i.e. individual choice)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection services are bundled with said registration services after transfer of ownership of a jewelry item to a consumer, the consumer paying an additional cost for loss protection services bundled with said registration services as disclosed by GemShield within Becker for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

As to claim 24, Becker does not explicitly disclose the method of claim 15 wherein said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer.

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However, GemShield discloses said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer (i.e. value added)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the marked jewelry item to the consumer as disclosed by GemShield within Becker for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

10. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker in view of S&P and GemShield.

As to claims 25 and 26, Becker discloses a method for providing registration services related to marked jewelry, comprising:  
registering a marked jewelry item in a database (i.e. diamond registration)((col. 4, lines 37-45);  
the marked jewelry item being transferred from the wholesaler to at least one additional entity;  
and,  
the database being updated to indicate transfers of the marked jewelry item (col. 7, lines 49-51).  
Becker does not explicitly disclose

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a wholesaler initiating said registration services and

the marked jewelry item being transferred from the wholesaler to at least one additional entity;

However, S&P discloses a wholesaler initiating said registration services (page 1).

Furthermore, S&P discloses the marked jewelry item being transferred from the wholesaler to at least one additional entity (i.e. wholesalers, retailers, ...)(see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a wholesaler initiating said registration services and the marked jewelry item being transferred from the wholesaler to at least one additional entity as disclosed by Mutual Insurance and within Becker for the motivation of providing coverage for the commercial jewelry industry (page 1).

Becker and S&P do not explicitly disclose

including the cost of the registration services in a cost of the marked jewelry item.

However, GemShield discloses including the registration services in the cost of the jewelry item (i.e. value added)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the registration services in the cost of the jewelry item as disclosed by GemShield within the Becker and S&P combination for the motivation of assuring customers that any loss will be replaced by the trusted jeweler (page 4).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Pat No. 5,828,405 discloses a gemstone registration system.

b. Pat. No. 5,124,935 discloses a gemstone identification system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Patent Examiner

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June 27, 2003